Paper 29

Filed by:

Fred E. McKelvey
Senior Administrative Patent Judge
Mail Stop Interference
P.O. Box 1450
Alexandria Va 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042

Filed 18 January 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Senior Administrative Patent Judge McKelvey)

ROBERT H. GRUBBS, DONALD W. WARD,
THOMAS J. SEIDERS and STEVEN D. GOLDBERG,

Junior Party
(Application 10/124,745),

v.

STEVEN P. NOLAN and JINKUN HUANG,

Senior Party
(Application 09/392,869).

Patent Interference No. 105,374
Technology Center 1600

REDECLARATION - Bd.R. 203(c)

A. Introduction

1. In the ORDER SETTING TIMES FOR TAKING ACTION--MOTIONS PHASE (Paper 27, Part B(5)), it was indicated that a formal order redeclaring the interference would be entered during the first week in January of 2006.

2. This REDECLARATION is intended to be that formal order.

B. Order

Substitution of Counts 4, 5 and 6 for Counts 1, 2 and 3

1. The parties have agreed that Count 4 should be substituted for Count 1 (Paper 1, pages 6-7); the board concurs (Paper 27, page 2, ¶ B(1)).

2. The parties have agreed that Count 5 should be substituted for Count 2 (Paper 1, pages 8-9); the board concurs (Paper 27, page 2, ¶ B(1)).

3. The parties have agreed that Count 6 should be substituted for Count 3 (Paper 1, pages 10-11); the board concurs (Paper 27, page 2, ¶ B(1)).

4. Count 4, which is set out in Appendix 1 of this REDECLARATION is substituted for Count 1 (Paper 1, pages 6-7).

5. Count 5, which is set out in Appendix 2 of this REDECLARATION is substituted for Count 2 (Paper 1, pages 8-9).

6. Count 6, which is set out in Appendix 3 of this REDECLARATION is substituted for Count 2 (Paper 1, pages 10-11).

Claim correspondence

7. In a MEMORANDUM OPINION and ORDER -- Bd.R. 104(a) (Paper 3), the board (1) invited Nolan to correct Fig. 4 of its drawings and (2) required the parties to submit a new set of claims.

8. Because the parties have agreed on a count which the board finds suitable, there is no need for the parties to file an amendment (Paper 29, pages 2-3, ¶¶ 6-9).

9. Accordingly, any amendments of the claims submitted by the parties need not be entered.

10. Instead, the interference can be resolved on the basis of the Grubbs and Nolan claims presently in the respective applications involved in the interference.

11. The claims of the parties are:

Grubbs: 1-34 and 40-75

Nolan: 9, 11-14, 17-21, 23-40, 43-65, 71-73 and 77-111

12. The claims of the parties which correspond to Count 4 are:

Grubbs: 1-15, 17-34 and 40-75

Nolan: 9, 11-14, 17-21, 23-40, 45-46, 51-63, 65, and 77-78, 89-92 and 107-109

13. The claims of the parties which do not correspond to Count 4 are:

Grubbs: 16

Nolan: 43-44, 47-50, 64, 71-73, 79-88, 93-106 and 110-111

14. The claims of the parties which correspond to Count 5 are:

Grubbs: 1-9, 11-15, 17-34, 40-48 and 64-74

Nolan: 14, 17-21, 23-26, 33-38, 43-44, 47-48, 53-58, 60-62, 77-78 and 90-111

15. The claims of the parties which do not correspond to Count 5 are:

Grubbs: 10, 16, 49-63 and 75

Nolan: 9, 11-13, 27-32, 39-40, 45-46, 49-52, 59, 63-65, 71-73 and 79-89

16. The claims of the parties which correspond to Count 6 are:

Grubbs: 1-9, 11-15, 17-34, 40-48 and 64-74

Nolan: 9, 11-14, 17-21, 23-38, 43-44, 49-62, 77-78, 90-92 and 107-109

17. The claims of the parties which do not correspond to Count 6 are:

Grubbs: 10, 16, 49-63 and 75

Nolan: 39-40, 45-48, 63-65, 71-73, 79-89, 93-106 and 110-111

Priority benefit

18. Consistent with discussion during a conference call (Paper 27, page 2, ¶ B(4)), the benefit accorded in the DECLARATION (Paper 1, pages 3 and 4) would be accorded.

19. Since no benefit was accorded in the DECLARATION, no benefit is accorded to either party with respect to any of Counts 4, 5 or 6.

Nolan request to amend its drawing

20. Nolan has filed an amendment to correct Fig. 4 of its drawings.

21. Entry of the amendment is being authorized in Grubbs v. Nolan, Interference 105,373.

/ss/Fred E. McKelvey
FRED E. McKELVEY,
Senior Administrative Patent Judge[1]

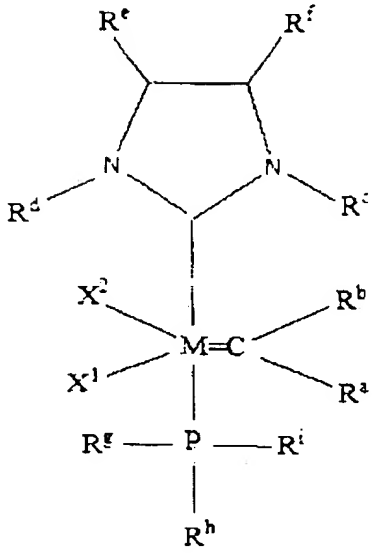
18 January 2006
Alexandria, VA

[1] As part of board efforts under the government Paperwork Elimination Act, signatures on papers originating from the board have been phased out in favor of a completely electronic record. Consequently, in this case papers originating at the board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 CFR § 10.18.

Appendix 1

Count 4

A composition of matter have the formula:



where:

M is Ru or Os;

X^1 and X^2 are each independently an anionic ligand;

P is phosphorus

R^a is:

(1) hydrogen,

(2) a hydrocarbyl group or

(3) a hydrocarbyl group substituted with a

(a) a C_{1-10} alkyl group,

(b) a C_{1-10} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with:

(i) halogen,

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group, and

R^b is:

(1) hydrogen,

(2) a carboxy group

(3) a hydrocarbyl group or

(4) a hydrocarbyl group substituted with a

(a) a C_{1-10} alkyl group,

(b) a C_{1-10} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with:

(i) halogen,

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group,

with the proviso that neither R^a or R^b can be

$$-C=C(Y)(Z)$$

where Y and Z are each independently any moiety;

R^c and R^d are each independently:

(1) hydrogen,

(2) a C_{2-20} alkoxycarbonyl group,

(3) a C_{1-20} carboxylato group,

(4) a C_{1-20} alkoxy group,

(5) a C_{2-20} alkenyloxy group,

(6) a C_{2-20} alkynyloxy group,

(7) an aryloxy group,

(8) a hydrocarbyl group or

(9) a hydrocarbyl group substituted with

(a) a C_{1-10} alkyl group,

(b) a C_{1-10} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with

(i) halogen

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group; and

R^e and R^f are each independently;

(1) hydrogen,

(2) a hydrocarbyl group,

(3) a C_{2-20} alkoxycarbonyl group,

(4) a C_{1-20} carboxylato group,

(5) a C_{1-20} alkoxy group,

(6) a C_{2-20} alkenyloxy group,

(7) a C_{2-20} alkynyloxy group,

(8) an aryloxy group,

where each R^e and R^f is optionally substituted with:

(a) a C_{1-5} alkyl group,

(b) a C_{1-5} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with:

(i) halogen,

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group;

R^g, R^h and R^i are each independently:

(1) a C_{1-10} alkyl group,

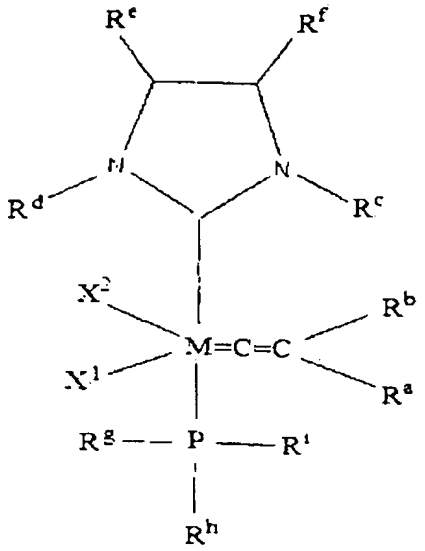
(2) a C_{3-10} cycloalkyl group or

(3) a C_{5-20} aryl group.

Appendix 2

Count 5

A composition of matter having the formula:



where:

M is Ru or Os;

X^1 and X^2 are each independently an anionic ligand;

P is phosphorus

R^a is:

(1) hydrogen,

(2) a hydrocarbyl group or

(3) a hydrocarbyl group substituted with a

(a) a C_{1-10} alkyl group,

(b) a C_{1-10} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with:

(i) halogen,

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group, and

R^b is:

(1) hydrogen,

(2) a carboxy group

(3) a hydrocarbyl group or

(4) a hydrocarbyl group substituted with a

(a) a C_{1-10} alkyl group,

(b) a C_{1-10} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with:

(i) halogen,

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group,

with the proviso that neither R^a or R^b can be

$$-C=C(Y)(Z)$$

where Y and Z are each independently any moiety;

R^c and R^d are each independently:

(1) hydrogen,

(2) a C_{2-20} alkoxycarbonyl group,

(3) a C_{1-20} carboxylato group,

(4) a C_{1-20} alkoxy group,

(5) a C_{2-20} alkenyloxy group,

(6) a C_{2-20} alkynyloxy group,

(7) an aryloxy group,

(8) a hydrocarbyl group or

(9) a hydrocarbyl group substituted with

(a) a C_{1-10} alkyl group,

(b) a C_{1-10} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with

(i) halogen

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group; and

R^e and R^f are each independently;

(1) hydrogen,

(2) a hydrocarbyl group,

(3) a C_{2-20} alkoxycarbonyl group,

(4) a C_{1-20} carboxylato group,

(5) a C_{1-20} alkoxy group,

(6) a C_{2-20} alkenyloxy group,

(7) a C_{2-20} alkynyloxy group,

(8) an aryloxy group,

where each R^e and R^f is optionally substituted with:

(a) a C_{1-5} alkyl group,

(b) a C_{1-5} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with:

(i) halogen,

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group;

R^g, R^h and R^i are each independently:

(1) a C_{1-10} alkyl group,

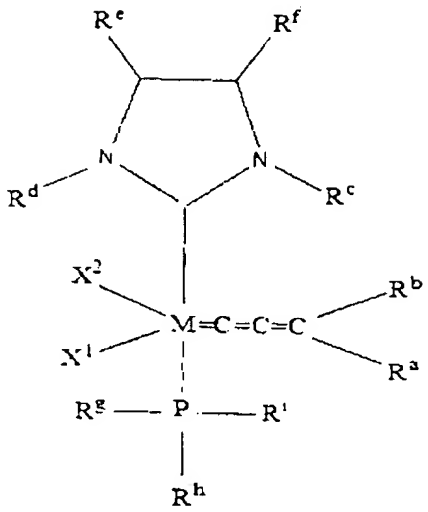
(2) a C_{3-10} cycloalkyl group or

(3) a C_{5-20} aryl group.

Appendix 3

Count 6

A composition of matter having the formula:



where:

M is Ru or Os;

X^1 and X^2 are each independently an anionic ligand;

P is phosphorus

R^a is:

(1) hydrogen,

(2) a hydrocarbyl group or

(3) a hydrocarbyl group substituted with a

(a) a C_{1-10} alkyl group,

(b) a C_{1-10} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with:

(i) halogen,

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group, and

R^b is:

(1) hydrogen,

(2) a carboxy group

(3) a hydrocarbyl group or

(4) a hydrocarbyl group substituted with a

(a) a C_{1-10} alkyl group,

(b) a C_{1-10} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with:

(i) halogen,

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group,

with the proviso that neither R^a or R^b can be

$$-C=C(Y)(Z)$$

where Y and Z are each independently any moiety;

R^c and R^d are each independently:

(1) hydrogen,

(2) a C_{2-20} alkoxycarbonyl group,

(3) a C_{1-20} carboxylato group,

(4) a C_{1-20} alkoxy group,

(5) a C_{2-20} alkenyloxy group,

(6) a C_{2-20} alkynyloxy group,

(7) an aryloxy group,

(8) a hydrocarbyl group or

(9) a hydrocarbyl group substituted with

(a) a C_{1-10} alkyl group,

(b) a C_{1-10} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with

(i) halogen

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group; and

R^e and R^f are each independently;

(1) hydrogen,

(2) a hydrocarbyl group,

(3) a C_{2-20} alkoxycarbonyl group,

(4) a C_{1-20} carboxylato group,

(5) a C_{1-20} alkoxy group,

(6) a C_{2-20} alkenyloxy group,

(7) a C_{2-20} alkynyloxy group,

(8) an aryloxy group,

where each R^e and R^f is optionally substituted with:

(a) a C_{1-5} alkyl group,

(b) a C_{1-5} alkoxy group,

(c) halogen or

(d) a phenyl group substituted with:

(i) halogen,

(ii) a C_{1-5} alkyl group or

(iii) a C_{1-5} alkoxy group;

R^g, R^h and R^i are each independently:

(1) a C_{1-10} alkyl group,

(2) a C_{3-10} cycloalkyl group or

(3) a C_{5-20} aryl group.

cc (via electronic mail):

Attorney for Grubbs
(real party in interest
California Institute of Technology):

Lisa A. Haile, Esq.
Antony M. Novom, Esq.
Email: lisa.haile@dlapiper.com
Email: antony.novom@dlapiper.com

Attorney for Nolan
(real party in interest
University of New Orleans Foundation):

R. Andrew Patty II, Esq.
Mary H. Drabnis, Esq.
Email: rap@patentcounsel.com
Email: mhd@patentcounsel.com